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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,487	06/23/2003	Daniel Castro	50623.305	6004

7590

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EXAMINER

MICHENER, JENNIFER KOLB

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/602,487

Applicant(s)

CASTRO ET AL.

Examiner

Jennifer K. Michener

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 94-183 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 94-163, 165-175 and 177-183 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. In light of a prior art search, Examiner has reconsidered her restriction requirement as the inventions of the independent claims are considered obvious variants of one another. Therefore, while Examiner appreciates Applicant's election of Group I, Groups I-IV will be examined together, below. Examiner maintains the election of species requirement and notes Applicant's election of "dispenser not being in contact with stent" with traverse. The traversal is on the ground(s) that species/inventions must be independent and distinct. This is not found persuasive because in the criteria and guidelines for making elections/restrictions in the MPEP, the inventions must be found to be independent or distinct (see MPEP 802.01, 802.02, 803, 808.01, 806.04 (f), 806.06).

The requirement is still deemed proper and is therefore made FINAL.

Claims 164 and 176 are withdrawn from consideration.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 94-163, 165-175, and 177-183 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Independent claims 94, 110, 160, and 172, and those depending therefrom are unclear.

The claims are directed to a "manufacturing method...for the application of a coating substance" or some variation thereof, however the method steps do not accomplish the stated purpose of the claim. The method steps merely require causing a coating dispenser to be moved such that the dispenser avoids application of coating substance in a space between frame structures. There are no active method steps of applying a coating substance and it is unclear if Applicant requires a coating step. The phrase "for the application of a coating substance" does not limit the claims to a coating method step in so much as it is an intended use. Prior art teaching moving dispenser/stent and avoiding application of coating substance in a space between frame structures (i.e., if no coating is applied anywhere) would read on the claims. The passive phrase "causing" regarding the stent/dispenser to be moved is so broad as to be meaningless as it would arise from all causes of movement, including initial placement of the stent in the stent holder, so long as such placement is along some portion of the pattern of the stent.

Examiner has given claims their broadest reasonable interpretation. For example, claim 103 requires that the stent be capable of moving, but does not require that the stent move. Claims 109, 119, 120, 126 contain similar language.

Examiner respectfully suggests Applicant re-institute active language directed to a coating operation method step.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 110, 111, 114, 117, 118, 119, 120, 125, 126, 132, 156, and 159 are rejected under 35 U.S.C. 102(b) as being anticipated by Tuch (5,679,400).

Tuch teaches coating a stent with a dispenser using spray bursts. Between spray bursts, there is a time delay during which the stent is moved or rotated (Example 9; Example 1). Such movement inherently follows a path defined by a pattern of a frame structure. For example, some portion of one of the many frame structures will provide a path from one position to another that would yield a rotational movement of the stent. Additionally, the frame structures define the stent, which is a tubular member, therefore a rotational path would be defined by frame structures of a tubular member.

The movement of the stent occurs between coating bursts, therefore, the movement avoids application of coating substance in a space between frame structures because, in fact, during this time of movement, application is avoided altogether.

Alternatively, it is noted that Tuch teaches coating only one half of the stent at a time (one end versus the other), therefore, coating is not applied in "a space" (singular) of the end not being coated. The claim requires only that application be avoided in a single space.

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Tuch teaches the dispenser and stent being in close proximity and that the stent is moved in intervals. The dispenser and stent are "capable" of moving in the ways claimed by Applicant. Tuch teaches coating with polymers and therapeutic agents.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 94-95, 98, 101, 102-103, 109, 130, , 140, 141, 154, 158, 159-163, 165-167, 172-175, and 177-179 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuch.

Tuch teaches that which is disclosed above. What Tuch fails to specifically teach is that the dispenser may be moved instead of the stent. However is it Examiner position that all motion is relative. It would have been obvious to an ordinary artisan to move the dispenser in relation to the stent or to move both relative to each other with the expectation of similar, successful results. Tuch also fails to specifically teach operating the movement by computer. It is Examiner's position that performing an operation in an automated fashion, such as with a computer, instead of by hand would have been within the skill of an ordinary artisan and does not patentably distinguish the process.

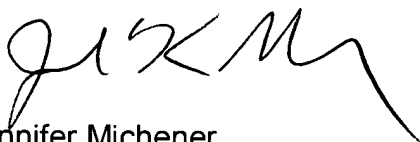
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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer K. Michener whose telephone number is (571) 272-1424. The examiner can normally be reached on Mondays & on Tuesday and Wednesday afternoons.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jennifer Michener
Primary Examiner
AU 1762
March 6, 2006